

## REMARKS/ARGUMENTS

Claims 1 to 3, 5, 10, 11 and 14 to 19 are pending. Claims 1 to 3, 5, 10, 11 and 14 to 17 have been rejected in the Office Action. Claims 4, 6 to 9, 12 and 13 are cancelled. New Claims 18 and 19 find support on page 4, lines 10 to 31.

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for the obviousness rejections set forth in the Office Action:

(a) A patent may not be obtained though the Invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The first three factual inquires listed by the Supreme Court' Graham decision are mandatory and must be decided in the record before any legal decision of obviousness can be made. This is a mandatory substantive requirement and matter. The factual basis and analysis underlying each of the three mandatory factual determinations/resolutions must be in the record. The obviousness rejections herein are fatally defective because there is no factual determination in the record of the level of the ordinary skill in the art. Withdrawal of the obviousness rejection is therefore again requested. As per the Supreme Court's Graham and KSR decisions, the mandatory first three factual inquiries form the foundation necessary before the legal decision of obviousness to one ordinarily skilled in the art can be made under Section 103(a). Such foundation must be present in the record before the secondary factors can be considered and used under Section 103(a), as per the Graham and KSR decisions.

Claims 1, 2, 5, 10 and 14 to 17 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 5,341,930 (Counts et al.) in view of U.S. Patent No. 5,389,415 (Kaufmann). Applicant traverses this rejection.

The burden of proof under Section 103(a) is still upon the Examiner. The Examiner has not carried his burden of proof and he can never even start to carry his burden of proof until he has built in the record the framework required by the Supreme Court. The Examiner has not factually established in the record a *prima facie* showing of obviousness for the same reason, for example.

The Office Action stated that Counts et al. discloses a packaging bag (Figures 1 and 2) with a front wall (14) and rear wall (12) in which the front wall and rear wall are bonded together along a peripheral edge (column 6, lines 39 to

47), each of the front wall and the rear wall being continuous and uninterrupted so as to not have any hole therein, at least one of the front wall and rear wall bonded to cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and at least one of the front wall and rear wall of the packaging bag printed on the outside of the bag (at 20). The entire purpose of Counts et al. is to completely remove a separable overlay (containing advertisement) from the package. This purpose and function of Counts et al. directs one ordinarily skilled in the art away from applicant's claimed invention, which requires an overlay to be peelable from the package except for on portion that is permanently bonded to the package (thereby the overlay can be swung to read print on its backside and/or the package surface).

Counts et al.'s separable overlay does not have any portion thereof that is permanently bonded to any part or portion of Counts et al.'s package. This factor alone directs away from applicant's claimed invention. Also, to insert permanent bonding of part of Counts et al. overlay would destroy the very purpose and invention of Counts et al. Accordingly, Counts et al. is not a very relevant reference except in the fact that Counts et al. directs one ordinarily skilled in the art away from applicant's claimed invention. The Examiner does not have any basis under Section 103(a) to oppose this statement because the Examiner has not factually determined in the record the level of ordinary skill in the art (and hence does not know anything about one ordinarily skilled in the art).

The Office Action stated that Counts et al. does not disclose a portion of the cover film being permanently bonded to the packaging film. Not only that,

any such permanent bonding would destroy the purpose and invention of Counts et al.

The Office Action stated that, however, Kaufmann discloses a substantial portion of a cover film (2) bonded to and peelable from a package and a remaining portion (5) of the cover film permanently bonded to a packaging bag in an edge area. This is of no import under Section 103(a) because the very purpose of Counts et al. is to completely remove the overlay and to permanently bond part of the overlay would destroy the purpose of Counts et al. A reference (e.g., Counts et al.) should be considered as a whole and portions arguing against or teaching away from the claimed invention must be considered.

Bausch & Lomb, Inc. v. Barnes- Hind/Hydrocurve, Inc., 230 USPQ 416 (CAFC 1986).

The Office Action stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the packaging bag of Counts et al. with the peelable and permanent seal combination teaching of Kaufmann as claimed, as such a modification would predictably permanently retain the cover film with the bag of Counts et al., yet allow its substantial peeling to ascertain text hidden beneath the cover film, as suggested by Kaufmann. This statement has no basis in patent law because the Examiner has not factually determined in the record the level of ordinary skill in the art, and cannot make any valid statement of what would be obvious to one ordinarily skilled in the art. (The prior obviousness rejections and the present obviousness rejections suffer the same fatal defects. The Examiner still has the burden proof.) The claimed invention is not obvious if a prior art reference

teaches away from the claimed invention (e,g,. Counts et al.). Gillette Co. v. S.C. Johnson & Sons, Inc. 16 USPQ2d 1923 (CAFC 1990).

Also, one ordinarily skilled in the art would not use Kaufman in combination with Counts et al. because the use of permanent bond on any part of the overlay would destroy the purpose and invention of Counts et al. The purpose and invention of Counts et al. is to be able to remove the overlay containing advertisement so as to extend the full price life of the packaged goods. If a portion of the overlay remained permanently bonded, then the purchaser would see that the packaged goods had not earlier sold and would want a discount (thereby destroying the purpose and invention of Counts et al.).

It is impermissible within the framework of Section 103(a) to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1965).

The Office Action set out the following irrelevant quotation "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396. Secondary consideration, such as this one, cannot be used in the present case. The reason is that the KSR decision requires that the framework of the three mandatory factual inquiries has to be in existence (which is not so in this case) before the secondary consideration have any meaning under Section 103(a). The Examiner has not factually determined in

the level of ordinary skill in the art, so the mandatory framework does not exist in this case.

The Office Action stated that, as to Claim 2, Counts et al. discloses a first packaging film (14), a second packaging film (12) and a cover film (16). Applicants traverse this rejection of dependent Claim 2. Independent Claim 1 is patentable, so dependent Claim 1 is patentable.

Office Action stated that, as to Claim 5, Counts et al. also sets forth the process of manufacture as claimed. Independent Claim 1 is patentable, so dependent Claim 5 is patentable.

The Office Action stated that, as to Claim 10, Counts et al. discloses bonding of the cover film in an edge area. Independent Claim 1 is patentable, so dependent 10 is patentable.

The Office Action stated that, as to Claim 14, Kaufmann further disclose employing permanent adhesive (see column 2, lines 43 to 55). Independent Claim 1 is patentable, so dependent Claim 14 is patentable.

The Office Action stated that, as to Claim 15, since the prior art combination discloses printing in general, and applicant discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment. Independent Claim 1 is patentable, so Claim 15 is patentable. Also, since the Examiner has not made the mandatory factual determination in the record of the level of the ordinary skill in the art, the Examiner does not know what would be obvious to one ordinarily skilled in the art. The Examiner has made the speculative

statement that there is no new and unexpected result. Applicant traverses this assertion by the Examiner and requests that the Examiner prove by citation of supporting reference, facts and/or his own declaration.

The Office Action stated that applicant's arguments with respect to Claims 1 to 3, 5, 10, 11 and 14 to 17 have been considered but are moot in view of the new grounds of rejection. The Examiner still has not made an obviousness rejection that is valid and complies with the mandatory requirements of the Supreme Court's Graham and KSR decisions and Patent Office policy.

The Office Action stated that, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references; and that applicant should see *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant traverses this statement as being completely wrong and in error. In the prior amendment, for example, page 9, line 21, to page 10, line 2, and page 10, lines 5 to 10 and 19 to 25, specifically deal with why the two rejection references cannot be combined, particularly in the manner unsuccessfully attempted by the Examiner.

The Office Action stated: that applicant maintains to believe that any modification of one reference with the teaching of another "destroys" the modified reference; that this argument can be used for any construction, as employing applicant's rationale, any change in an existing structure "destroys" the existing structure; that neither the Examiner, nor the Patent Office, recognizes that any modification destroys a base reference by it merely being modified; that the

Examiner questions whether, thinking in a common sense way, would replacing a container with an entirely removable closure on a container with a hinged or tethered closure “destroy” the container; that not in the Examiner’s vision, it would just change the capabilities of the container in an expected way. Applicant traverse this statement. First it does not correctly state applicant’s position. As applicant stated, the permanent bonding of Kaufmann of any portion of the overlay would destroy the invention of Counts et al. that required complete removal of the overlay. This point and destruction of the purpose of Counts et al.’s invention is discussed in detail above. The Examiner’s reference to thinking in a common sense way is meaningless until he has factually determined in the record the level of ordinary skill in the art.

The inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the claimed invention as a whole (to one ordinarily skilled in the art). *Hartness International, Inc. v. Simplimatic Engineering Co.*, 2 USPQ2d 1826 (CAFC 1987). The Examiner cannot make such a determination because he has not factually determined in the record the level of ordinary skill in the pertinent art.

The Office Action stated that the modification of Counts et al. in view of Kaufman is also maintained to be obvious in order to obtain a non-removable cover; that the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; that applicant should see *In re Fine*, 837 F.2d

1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); that, in this case, Kaufmann discloses a printed cover film being reusablely peelable from a bag and resealable thereto, to render the packaging bag recoverable by the printed cover film, which is what is desired by applicant in his packaging bag. Applicant traverses this statement. The Examiner does not know what would be obvious to one ordinarily skilled in the art. To merely say it was obvious, as done by the Examiner, is meaningless under Section 103(a). One ordinarily skilled in the art would look at Kaufman and throw it away upon see that permanent bonding of a part of the overlay would defeat the purpose and invention of Counts et al. The two lower court decisions cited by the Examiner are not meaningful in the situation at bar because the Examiner has not yet complied with the Supreme Court's requirement of constructing the framework that it mandated. Hindsight is not a proper criterion for resolving the issue of obviousness. *Ex parte Clapp*, (BOPAAI 1985).

Each prior art reference must be evaluated as an entirety, and all of the prior art must be evaluated as a whole. *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337 (CAFC 1985).

The Examiner is requested to make, and support factually, in the record the mandatory factual determination in the record of the level of ordinary skill in the art. This will allow applicant to have the right, now denied him, to review such determination and its asserted support, and then to agree or disagree (and oppose) with such determination and its asserted support. Applicant has been denied his right regarding this substantive matter.

This rejection should be withdrawn.

Claims 3 and 11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to Claim 1 above, and further in view of U.S. Patent No. 6,767,604 (Muir et al.). Applicant traverses this rejection.

The attempted combination of Counts et al. and Kaufmann does not make any of applicants' claims obvious. Muir et al. does not cure the defects of the basic rejection combination so adding Muir et al. does not make either Claim 3 or Claim 11 obvious. In fact, the attempted inclusion of Muir et al. in the rejection combination would be rejected by one ordinarily skilled in the art because Muir et al. would destroy the purpose and invention of Counts et al. The reason is that Muir et al. uses heat sealed portion 38 of tab 12 while Counts et al. requires that its overlay be completely removable from the package. (Tab 12 serves a closable hinged lid that provides access to the package contents via hole 38 in the package wall.)

The Office Action stated: that Muir et al. disclose the front wall and the rear wall of a similar bag being of the same packaging film by folding (see column 3, lines 46 to 61; and that to provide the front and rear walls of Counts et al. as folded portions of the same material would have been obvious, as it is well-known in the bag field to provide a bag by folding a single sheet, as disclosed by Muir et al. The Examiner has only said "would have been obvious" which is inadequate under Section 103(a).

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

Date: December 31, 2008

Virgil H. Marsh

Virgil H. Marsh

Reg. No. 23,083

Fisher, Christen & Sabol  
1120 M St., NW  
South Tower, Suite 750  
Washington, DC 20036  
Tel.: 202-659-2000  
Fax: 202-659-2015  
[fcsabol@aol.com](mailto:fcsabol@aol.com)